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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/073,370	05/05/98	MAHANT-SHETTI S	T1-21674

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EXAMINER	
NGUYEN, L	

ART UNIT	PAPER NUMBER
2612	9

DATE MAILED: 10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/100,952	Applicant(s) PARK ET AL.	
	Examiner Polin Chieu	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 August 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Response to Arguments

1. Applicant's arguments filed 8/23/01 have been fully considered but they are not persuasive. Yuen et al (6,154,203) teaches a program guide with a picture-in-picture window (42) continuing the program without interruption in figure 2. Although the video is reduced the video is not interrupted. Young et al (5,479,266) discloses a program guide as well, but the program guide does not provided uninterrupted viewing. The motivation for combining would be to allow the user to set recording using the program guide without interrupting the program as discussed in section 2, lines 11-13 of the first office action. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Regarding Lawler et al (5,699,107) the applicant has misinterpreted the cited portion (144 in figure 10). Although Lawler et al does offer a reminder feature (figure 8), the previous office action reference figure 10. The record feature is similar to the reminder function; however, the record function records the marked program and does not just produce notification that the program is will be shown soon like the reminder feature (col. 13, lines 38-64).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al in view of Lawler et al and Yuen et al.

Young et al discloses pre-storing program identification information (232) contained in broadcast programs of broadcast stations (col. 12, lines 60 and col. 13, lines 1-11); selecting reserve-recording (col. 5, lines 45-55); reading program identification information corresponding to the selected program among the pre-stored data (col. 13, lines 25-35); and setting reserve-recording data with the program identification information (col. 13, lines 25-35). However, Young et al does not disclose that the viewing of the program is maintained, and that selecting reserve-recording is with respect to the broadcast program. Yuen et al discloses maintaining the viewing of a broadcast program in figure 2. It would have been highly desirable to maintain the viewing of a broadcast program so that the program would not be interrupted during reserve-recording. Lawler et al discloses that selecting reserve-recording is respect to the broadcast program (144) in figure 10. It would have been highly desirable to select reserve-recording with respect to the broadcast program so that the user could record the program that is being watched. Therefore, it would have been obvious to a person

of ordinary skill in the art at the time of the invention to maintain the viewing of a program while selecting reserve-recording with respect to the broadcast program in Young et al.

Regarding claim 2, Young et al does not specifically state that the program identification information contains broadcast titles, broadcast data, time, and channel data. However, in figure 1 a display is generated showing all the program identification information listed above. Clearly this must be contained in the program identification information since the display is generated from the program identification information. Young et al discloses that the reserve-recording data includes channel data, recording date and time (col. 13, lines 25-35). Although recording date is not specifically stated, the recording date is inherent since the recorder can not properly record the program without it.

Regarding claim 3, Young et al discloses a VCR (252) and a television (210) in figure 22B.

The limitations recited in claim 4 were discussed in the art rejection of claim 3. Please refer to the art rejection of claim 3.

Regarding claim 5, Young et al discloses a first storage unit (232), a key input unit (212), and a second storage unit (236) in figure 22A. Young et al also discloses reading the program identification information corresponding to the broadcast program, and setting reserve-recording information as discussed in claim 1. However, Young et al does not disclose maintaining a current broadcast, and that the currently viewed broadcast is being reserve-recorded. Yuen et al discloses maintaining a current

broadcast program in figure 2. It would have been highly desirable to maintain the viewing of a broadcast program so that the program would not be interrupted during reserve-recording. Lawler et al discloses that a key input signal reserve-records a viewing broadcast program (144) in figure 10. It would have been highly desirable to have the key input signal reserve-records a viewing broadcast program so that the user could record the program that is being watched. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to maintain the viewing of a program while that a key input signal reserve-records a viewing broadcast program in Young et al.

Regarding claim 5, Young et al discloses reading program identification information from the program identification information stored in the first storage unit (col. 13, lines 25-35).

Regarding claim 7, Young et al discloses a VCR (252) and a television (210) in figure 22B.

Regarding claim 8, please refer to the art rejection of claim 7.

Regarding claim 9, Young et al discloses receiving a broadcast signal from an antenna (200) and extracting program identification information (222); storing the program identification information (232); determining if a reserve key signal is input be a user for reserve-recording (214); and reading the program identification information corresponding to the broadcast program from the first memory (232), setting reserve-recording information and storing it in a second memory (236) in figure 22A. However, Young et al does not disclose maintaining the viewing without interruption, and

recognizing the viewing broadcast program as a broadcast program to be reserve-recorded. Yuen et al discloses maintaining the viewing without interruption in figure 2. It would have been highly desirable to maintain the viewing without interruption so that the user does not miss any part of the program. Lawler et al discloses recognizing the viewing broadcast program as a broadcast program to be reserve-recorded (144) figure 10. It would have been highly desirable to recognizing the viewing broadcast program as a broadcast program to be reserve-recorded so that the user could record the program being watched. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to maintain the viewing without interruption, and recognize the viewing broadcast program as a broadcast program to be reserve-recorded in Young et al.

The limitations of claim 10 were discussed in the art rejection of claim 2. Please refer to the art rejection of claim 2.

Regarding claim 11, Young et al discloses a VCR (252) and a television (210) in figure 22B.

Please refer to the art rejection of claim 11.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-F 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R. Garber can be reached on (703) 305-4929. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

PC
October 18, 2001

WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600